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AUG 21 2009

OFFICE OF PETITIONS

ON PETITION

In re Application of :  
Harper et al. :  
Application No. 10/091,284 :  
Filed: March 5, 2002 :  
Attorney Docket No. 10660-070US(10279P1) :

This is a decision on the "Petition To Correct Declaration Under 37 CFR §1.63" filed on June 8, 2009.

The petition is dismissed.

Any request for reconsideration must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 C.F.R. § 1.136(a) are not permitted. The reconsideration request should include a cover letter entitled "Renewed Petition". This is **not** a final agency action within the meaning of 5 U.S.C. § 704.

Petitioner seeks to correct the citizenship of the inventor John Douglas Morgan to reflect that he is Australian as opposed to "United" under 37 CFR 1.182. Petitioner contends that there is no statutory requirement that the oath include citizenship. Thus petitioner maintains that the previously submitted assignment, which states the correct citizenship of inventor Morgan meets the requirements of 35 USC §115. Petitioner acknowledges that MPEP §605.01 requires that a supplemental oath or declaration is required when the citizenship has not been provided. Petitioner states that a letter requesting that the inventor execute a substitute declaration was mailed. However, Federal Express was unable to deliver the letter because the address provided was incorrect. As such petitioner requests that the assignment be accepted to correct the citizenship.

**APPLICABLE RULES AND REGULATIONS**

35 U.S.C. 25 Declaration in lieu of oath.

(a) The Director may by rule prescribe that any document to be filed in the Patent and Trademark Office and which is required by any law, rule, or other regulation to be under oath may be subscribed to by a written declaration in such form as the Director may prescribe, such declaration to be in lieu of the oath otherwise required.

35 U.S.C. 115 Oath of applicant.

The applicant shall make oath that he believes himself to be the original and first inventor

for which he solicits a patent; and shall state of what country he is a citizen.

§ 1.63 Oath or declaration.

(a) An oath or declaration filed under § 1.51(b)(2) as a part of a nonprovisional application must:

- (1) Be executed, i.e., signed, in accordance with either § 1.66 or § 1.68. There is no minimum age for a person to be qualified to sign, but the person must be competent to sign, i.e., understand the document that the person is signing;
- (2) Identify each inventor by full name, including the family name, and at least one given name without abbreviation together with any other given name or initial;
- (3) Identify the country of citizenship of each inventor; and
- (4) State that the person making the oath or declaration believes the named inventor or inventors to be the original and first inventor or inventors of the subject matter which is claimed and for which a patent is sought.

Petitioner's argument has been considered but not been deemed persuasive. 35 USC 115 requires in an oath that each applicant state what country he is a citizen. 35 USC 25 allows for the Director by rule to prescribe that any document to be filed in the Office which is required by any law, rule or other regulation to be under oath may be subscribed to by a written declaration to be in lieu of the oath. The Director has prescribed in 37 CFR 1.63 that an oath or declaration must include the citizenship of an inventor. The assignment previously submitted does not meet the requirement that the citizenship be provided in the oath or declaration.

The manner in which the citizenship can be corrected is via the submission of an executed supplemental declaration. 37 CFR 1.67 requires in the supplemental oath or declaration substantially all the data called for in 37 CFR 1.63 for the original oath or declaration. Deficiencies or inaccuracies in an oath or declaration may be corrected by a supplemental oath or declaration. The supplemental oath or declaration must (1) identify the entire inventive entity, and (2) be signed by all the inventors when the correction relates to all the inventors or applicants (37 CFR 1.42, 1.43, or 1.47), or by only those inventor(s) or applicants (37 CFR 1.42, 1.43, or 1.47) to whom the corrections relates. See 37 CFR 1.67(a).

When an inventor who executed the original declaration is refusing or cannot be found to execute a required supplemental declaration, the requirement for that inventor to sign the supplemental declaration may be suspended or waived in accordance with 37 CFR 1.183. All available joint inventor(s) must sign the supplemental declaration on behalf of themselves, if appropriate, and on behalf of the nonsigning inventor. See MPEP § 409.03(a). If there are no joint inventor(s), then the party with sufficient proprietary interest must sign the supplemental declaration on behalf of the nonsigning inventor. See MPEP § 409.03(b).

Proof that the non-signing inventor is unavailable or cannot be found similar to the proof required for a petition under 37 CFR 1.47 must be submitted with the petition under 37 CFR 1.183 (see MPEP § 409.03(d)). Petitioner must establish that inventor has refused or cannot be found. The evidence provided on petition fails to establish that inventor Morgan

cannot be located. The evidence failed to provide that any effort was made to locate the inventor once it was determined the supplemental declaration was mailed to the incorrect address.

The address given on the petition differs from the address of record. If appropriate, a change of address should be filed in accordance with MPEP 601.03. A courtesy copy of this decision is being mailed to the address given on the petition; however, the Office will mail all future correspondence solely to the address of record.

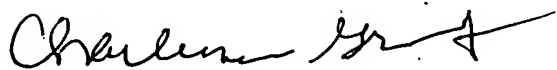
Further correspondence with respect to this matter should be addressed as follows:

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By fax:                   (571) 273-8300  
                              ATTN: Office of Petitions

Telephone inquiries regarding this communication should be directed to the undersigned at (571) 272-3215.



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